

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Patent Application of Gregory Flickinger.

Conf. No.: 5795 : Group Art Unit: 2623
Appln. No.: 09/749,255 : Examiner: Jason P. Salce
Filing Date: 27 December 2000 : Attorney Docket No.: T727-10

Title: Scheduling and Presenting IPG Ads in Conjunction with Programming Ads in a Television Environment

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF
UNDER 37 C.F.R. § 41.37(d) – AMENDED APPEAL BRIEF

In response to the Notice of Non-Compliant Appeal Brief, dated October 4, 2007, and further to the Appeal Brief filed June 18, 2007, the Final Rejection dated June 30, 2006 and the Notice of Panel Decision from Pre-Appeal Brief Review dated May 18, 2007, Applicants hereby submit an Amended Appeal Brief in accordance with 37 C.F.R. §41.37 for the above-referenced application.

(A) **REAL PARTY IN INTEREST**

The real party in interest is Prime Research Alliance E., Inc., the Assignee of record, which is a wholly owned subsidiary of a privately-owned, non-publicly traded company.

(B) RELATED APPEALS AND INTERFERENCES

There are no prior or pending appeals, judicial proceedings or interferences known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

(C) **STATUS OF CLAIMS**

Claims 1, 6-9, and 13-27 are canceled.

Claims 2-5, 10-12, and 28-42 are pending, rejected and are appealed.

(D) STATUS OF AMENDMENTS

No amendment has been filed subsequent to the final rejection.

(E) SUMMARY OF CLAIMED SUBJECT MATTER

The currently pending independent claims in this application are claims 28 and 31. A concise explanation of each independent claim, with reference to the specification follows below. Independent claim 28 recites:

A method of enhancing the effectiveness of IPG ads and programming ads in a television network environment, the method comprising:

- (a) storing an IPG ad queue, the IPG ad queue containing an ordered list of IPG ads;
- (b) storing a programming ad queue, the programming ad queue containing an ordered list of programming ads to be inserted in a programming avail;
- (c) linking at least one IPG ad with at least one programming ad to form at least one IPG-programming ad combination;
- (d) displaying one or more IPG ads from the at least one IPG-programming ad combination in the IPG when the IPG is invoked immediately prior to or immediately subsequent to the display of a programming ad in the programming avail, wherein the IPG ads are displayed in accordance with the IPG ad queue; and
- (e) reordering the IPG ad queue in accordance with the displayed programming ad.

Independent claim 28 recites a method of enhancing the effectiveness of IPG (Interactive Programming Guide) ads and programming ads in a television network environment. (see, for example, Fig. 1 and page 5, line 27 through page 6, line 2, page 3, lines 26-31, page 4, lines 1-10, page 4, lines 11-25, page 2, line 6-8, and page 6, lines 4-16 of the specification). The method includes using an IPG ad queue contains an ordered list of IPG ads. (see, for example, Fig. 3 and page 13, lines 12-18 of the specification). A programming ad queue is stored and contains an ordered list of

programming ads. (see, for example, Fig. 4 and page 13, lines 12-18 of the specification). The IPG ads are linked to programming ads. (See, for example Fig. 3 and page 13, lines 12-18 of the specification).

An IPG ad is displayed upon invoking the IPG. (see, for example, page 13, lines 4-11 and page 14, lines 17-23 of the specification) The IPG ad queue is reordered in accordance with the displayed programming ad. (See, for example, page 6, lines 7-16 and page 17, lines 6-7 of the specification).

Independent claim 31 recites:

A method of enhancing the effectiveness of IPG ads and programming ads in a television network environment, the method comprising:

- (a) storing an IPG ad queue, the IPG ad queue containing an ordered list of IPG ads;
- (b) storing a programming ad queue, the programming ad queue containing an ordered list of programming ads to be inserted in a programming avail;
- (c) linking at least one IPG ad with at least one programming ad to form at least one IPG-programming ad combination;
- (d) displaying one or more IPG ads from the at least one IPG-programming ad combination in the IPG when the IPG is invoked immediately prior to or immediately subsequent to the display of a programming ad in the programming avail, wherein the IPG ads are displayed in accordance with the IPG ad queue; and
- (e) reordering the IPG ad queue in accordance with a reordering of the programming ad queue.

Aspects (a)-(c) of claim 31 are identical to aspects (a)-(c) of claim 28. Aspects (d) and (e) are similar to the above described aspects, however, instead of reordering the IPG ad queue in accordance with the displayed programming ad, the IPG ad queue is

reordered in respect to a reordering of the programming ad queue (See, for example, page 14, lines 22-23 of the specification).

(F) GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review in this appeal:

- (1) Whether claims 10, 12, 28-33, 38, and 40-42 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,177,931 to Alexander et al. ("Alexander") in view of U.S. Patent No. 6,002,393 to Hite et al. ("Hite").
- (2) Whether claims 2-3, 5, 34-35, and 37 are unpatentable under 35 U.S.C. §103(a) over Alexander in view of Hite in further view of U.S. Patent No. 6,738,978 to Hendricks et al. ("Hendricks")
- (3) Whether claims 4 and 36 are unpatentable under 35 U.S.C. §103(a) over Alexander in view of Hite in further view of Hendricks in further view of U.S. Patent No. 5,283,639 to Esch et. al. ("Esch")
- (4) Whether claims 11 and 39 are unpatentable under 35 U.S.C. §103(a) over Alexander in view of Hite in further view of U.S. Patent No. 6,799,326 to Boylan, III et. al. ("Boylan")

(G) ARGUMENTS

(1) Rejection under 35 U.S.C. §103(a) over Alexander in view of Hite

(a) Claims 10, 12, 28-33, 38 and 40-42

The Examiner has not established a *prima facie* case of obviousness to support the rejection of claims 10, 12, 28-33, 38 and 40-42 because (i) the Examiner has not established that there was an apparent reason to combine the references; (ii) the proposed combination would change the principle of operation of the primary reference; and (iii) all features of the claims are not taught by the proposed combination.

i. There Is No Apparent Reason Combine the References

In KSR, the Court stated that it was “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int’l Co. v. Teleflex Inc.* 127 S. Ct. 1727 (U.S. 2007). The Court noted, “[t]o facilitate review, this analysis should be made explicit.” *See KSR*. It is important to determine whether there was an “apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *See KSR*. Therefore, the Examiner must identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.

Alexander teaches showing a particular ad window and PIP window combination based on the item in the EPG that is currently selected (column 19, lines 13-37), while Hite teaches away from Alexander and suggests showing a particular programming ad based on the profile of the user as stored in the “Consumer Database” (column 7, lines 20-29). Due to these conflicting teachings, the combination of the two references is not a product of “common sense.” *See KSR*.

More specifically, Alexander (column 26, line 61 – column 27, line 2) teaches that the advertisement displayed should be based on the advertisement displayed before

entering the EPG. Alexander also suggests displaying a program (in the PIP window or ad window) based on the program related to the selected story, formatting the EPG based on the status of sporting events, and displaying a program related to the news story selected. When referencing the EPG display, Alexander teaches a method of correlating or linking what is displayed in the EPG to what is displayed in the PIP window. Hite, however, teaches showing a particular programming ad based on the user profile, not the selection of a particular element of the EPG. Since the two references function on different paradigms, one skilled in the art would not attempt to combine Alexander and Hite.

In dismissing Applicants' arguments concerning the reason to combine the references, the Examiner has selectively considered the queue taught by Hite and ignored the context in which the queue functions. The Examiner has seemingly ignored the "Basic Considerations Which Apply to Obviousness Rejections," that instruct the Examiner that "[t]he references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination," (see MPEP 2141). Further, MPEP 2141.02 instructs that "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention."

Therefore, removing the queue from the other teachings of Hite and ignoring the context in which the queue functions is improper. Previously, Applicant requested that the Examiner consider the context surrounding Hite's queue (see Amendment, pages 12-14), since, it appeared as though the Examiner did not consider Hite "as a whole." Instead, the Examiner decided that "[t]he only teaching used from Hite is that a queue can be used to store EPG ads," (Final Office Action, page 5) and that the differences in the teachings of the references need not be evaluated. Since the Examiner has not considered the whole of Hite, Applicants' arguments concerning the reason to combine the references have not been properly considered. One skilled in the art would see the methods of Alexander and Hite as presenting opposing techniques for managing EPG ads and therefore not seek to combine them.

Since the Examiner has not provided a proper reason to combine Alexander and Hite, the Examiner has not satisfied the burden of *prima facie* obviousness.

ii. The Proposed Combination Changes the Principle of Operation

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *See In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); MPEP § 2143.01.

Even if Alexander and Hite are combined as suggested by the Examiner, the inclusion of Hite's features would change the mode of operation of Alexander. More specifically, Hite would change the mode of operation of Alexander in respect to choosing what item to display. Alexander discloses linking items in the EPG to other items in the EPG and choosing what item to display based on the link between the items. Hite discloses displaying programming ads based on the user's profile. If Alexander were to choose what ad to display based on the user profile instead of based on the link, this would substantially change Alexander's mode of operation and the basic premise on which Alexander functions. Similar to the Examiner's flawed analysis in combining the references generally, the Examiner has not considered Hite "as a whole, including portions that would lead away from the claimed invention." Therefore, the combination of the references would change the mode of operation of the primary reference and that Applicant's arguments have not been fully considered.

iii. The Proposed Combination Does Not Teach or Suggest All Claim Elements

When making a rejection under 35 U.S.C. § 103, the prior art references, when combined, must teach or suggest all of the claim limitations. *See* MPEP 2143.03. The

combination of Alexander and Hite, even if proper, still does not teach or suggest all of the features of Applicants' claims.

In particular, Alexander in view of Hite does not teach or suggest either an "IPG ad queue containing an ordered list of IPG ads," displaying IPG ads "wherein the IPG ads are displayed in accordance with the IPG ad queue," or "reordering the IPG ads queue in accordance with the displayed programming ad," as recited in independent claim 28.

The Examiner has refused to acknowledge that the teachings of Alexander in view of Hite do not teach "reordering the IPG ad queue in accordance with the displayed programming ad." Alexander cannot teach the reordering of a queue because, according to the Examiner, Alexander does not teach "the specific memory structure of a queue to store the IPG and programming ads..." (see Non-Final Office Action, page 4). Alexander does teach that ads can rotate, that ads may be assigned a priority, that the highest priority ad is displayed the first time a page is accessed, that the second highest priority ad is displayed the second time the page is accessed (etc.), and that the EPG may be timed to display a correlative ad to the ad that was being shown on the channel. However, a reference cannot teach how to reorder a data structure in the absence of actually teaching that data structure. As previously explained, a rotation of items is not the same as the reordering of a queue. The disclosure of Alexander does not provide a way to reorder a queue (nor does Hite provide for a way to reorder the queue), and therefore the combination of the references does not teach the "reordering the IPG ad queue in accordance with the displayed programming ad."

The Examiner argues that reordering the IPG ads may be separated from their connection to the queue. Therefore, the Examiner concludes that Alexander teaches reordering IPG ads. Applicant submits that as previously stated, reordering of an IPG ad queue cannot be taught in the absence of the queue. However, even if it can, Alexander does not teach reordering IPG ads. The Examiner argues that because "different ads can appear each time the user enters the same page/section of the Guide," that this is equivalent to the reordering recited in independent claim 28. Instead, such a teaching is what Alexander itself labels: "rotation," (see column 26, lines 45-48) – not reordering.

The Examiner also argues that displaying an ad correlative to the ad that was being shown on the channel at the time the viewer entered the EPG is equivalent to the reordering of claim 28. The display of an ad that correlates the ad that was being shown on the channel at the time the viewer entered the EPG is also not the same as “reordering the IPG ad queue in accordance with the displayed programming ad,” nor is it equivalent to reordering IPG ads stored in memory. Alexander does not teach how the display of an ad that correlates with the ad that was being shown on the channel at the time the viewer entered the EPG constitutes a reordering of IPG ads. Accessing an IPG ad in memory based on a correlation between the IPG ad and the ad shown on the channel and displaying the IPG ad does not change the order in which the IPG ad or other IPG ads are stored. Thus, the Examiner’s argument that accessing RAM in order to retrieve an IPG ad for display teaches the reordering aspect of independent claim 28 is incorrect.

Additionally, the Examiner has refused to acknowledge that Alexander does not teach “storing IPG ads..., the IPG ads being stored in an ordered list” (see page 3 of the Non-Final Office Action). The Examiner argues that column 5, lines 13-15 of Alexander teach an ordered list, while Applicant maintains that it does not (see Amendment, page 8). The Examiner claims this list is at least in a “random order,” (see Final Office Action, page 2). However, the words “[m]ore than one virtual channel ads may be stored in RAM, but preferably only one such ad is display at a time,” do not teach or suggest an ordered list. Further, items stored in a “random order” are not ordered within the meaning of claim 28 as the Examiner argues. The Examiner admits that Alexander is silent to what type of order the ads are stored in, (Final Office Action, page 2). In the absence of a teaching of some type of order, Alexander cannot teach an ordered list (see Amendment, page 9).

Claim 31 recites an IPG ad queue and “reordering the IPG ad queue in accordance with a reordering of the programming ad queue.” For all of the reasons above in relation to claim 28, claim 31 is believed to be patentable. Furthermore, the Alexander and Hite do not address reordering a programming ad queue and then reordering an IPG ad queue in accordance. At best, Alexander discloses displaying an ad correlative to the ad that was being shown on the channel at the time the viewer entered the EPG. This concept is

clearly distinguishable, because not only is it not the reordering of a queue, it is not in accordance with the reordering of a programming ad queue. Claims 10, 12, 29-30, 32-33, 38, 40, and 42 are allowable at least by their dependence on claims 28 and 31, respectively.

In view of the foregoing, Applicants respectfully submit that the combination of Alexander and Hite is improper since the Examiner has not established that it would make sense to combine them and such a combination would require a fundamental change in operation of the primary reference. Even assuming the references were properly combinable, which they are not, all features of independent claims 28 and 31 would still not be taught by the combination.

Therefore, the Examiner has not met the burden of *prima facie* obviousness. Accordingly, for the reasons detailed herein, independent claims 28 and 31, and all claims dependent thereon, including claims 10, 12, 28-33, 38 and 40-42, are allowable over the combination of Alexander and Hite.

(2) Rejection under 35 U.S.C. §103(a) over Alexander in view of Hite in further view of Hendricks

(a) Claims 2-3, 5, 34-35, and 37

For the same reasons discussed above with respect to the Examiner's rejection over Alexander in view of Hite, such combination does not render independent claims 28 and 31 obvious. Thus, claims 28 and 31 are believed to be allowable over Alexander in view of Hite. Applicant respectfully submits that Hendricks does not teach or suggest any of the aspects missing from Alexander in view of Hite. Thus, independent claims 28 and 31 are believed to be allowable over the combination of Alexander, Hite, and Hendricks. Dependent claims 2-3, 5, 34-35, and 37 are allowable at least by their dependency on independent claims 28 and 31, respectively. Therefore the Examiner's § 103(a) rejection of claims 2-3, 5, 34-35, and 37 should have been withdrawn. Since this

rejection is in error, Applicants respectfully request that the Board reverse the Examiner's rejection of claims 2-3, 5, 34-35, and 37.

(3) Rejection under 35 U.S.C. §103(a) over Alexander in view of Hite in further view of Hendricks in further view of Esch

(a) Claims 4 and 36

For the same reasons discussed above with respect to the Examiner's rejection over Alexander in view of Hite, such combination does not render independent claims 28 and 31 obvious. Thus, claims 28 and 31 are believed to be allowable over Alexander in view of Hite. Applicant respectfully submits that neither Hendricks nor Esch teaches or suggests any of the aspects missing from Alexander in view of Hite. Thus, independent claims 28 and 31 are believed to be allowable over the combination of Alexander, Hite, Hendricks, and Esch. Dependent claims 4 and 36 are allowable at least by their dependency on independent claims 28 and 31, respectively. Therefore the Examiner's § 103(a) rejection of claims 4 and 36 should have been withdrawn. Since this rejection is in error, Applicants respectfully request that the Board reverse the Examiner's rejection of claims 4 and 36.

(4) Rejection under 35 U.S.C. §103(a) over Alexander in view of Hite in further view of Boylan

(a) Claims 11 and 39

For the same reasons discussed above with respect to the Examiner's rejection over Alexander in view of Hite, such combination does not render independent claims 28 and 31 obvious. Thus, claims 28 and 31 are believed to be allowable over Alexander in view of Hite. Applicant respectfully submits that Boylan does not teach or suggest any of the aspects missing from Alexander in view of Hite. Thus, independent claims 28 and 31 are believed to be allowable over the combination of Alexander, Hite, and Boylan.

Dependent claims 11 and 39 are allowable at least by their dependency on independent claims 28 and 31, respectively. Therefore the Examiner's § 103(a) rejection of claims 11 and 39 should have been withdrawn. Since this rejection is in error, Applicants respectfully request that the Board reverse the Examiner's rejection of claims 11 and 39.

Conclusion

For the reasons set forth above, Applicants submit that the rejection of claims 2-5, 10-12, and 28-42 is in error, and that the application, including claims 2-5, 10-12, and 28-42 is in condition for allowance. Accordingly, Applicants respectfully request that the Board reverse the Examiner's rejections of claims 2-5, 10-12, and 28-42 and remand this application for issue.

(H) CLAIMS APPENDIX

1. (cancelled)

2. The method of claim 28, wherein at least one of the IPG ads or at least one of the programming ads is a targeted ad, thus forming a targeted IPG-programming ad combination.

3. The method of claim 2, wherein the targeted IPG-programming ad combination is assigned to at least one subscriber group, the at least one subscriber group comprising at least one subscriber.

4. The method of claim 3, wherein the targeted IPG-programming ad combination is formed prior to the assignment of the combination to the at least one subscriber group.

5. The method of claim 3, wherein the targeted IPG-programming ad combination is formed subsequent to the assignment of at least one IPG ad or at least one programming ad to the at least one subscriber group.

6-9. (cancelled)

10. The method of claim 28, wherein viewer interaction with an IPG ad allows a viewer to request additional information regarding a particular linked programming ad.

11. The method of claim 28, wherein viewer interaction with an IPG ad causes a related linked programming ad to be subsequently displayed.

12. The method of claim 28, wherein at least one IPG ad is displayed in the IPG when the IPG is invoked during the presentation of one of the programming ads.

13-27. (cancelled)

28. A method of enhancing the effectiveness of IPG ads and programming ads in a television network environment, the method comprising:

(a) storing an IPG ad queue, the IPG ad queue containing an ordered list of IPG ads;

(b) storing a programming ad queue, the programming ad queue containing an ordered list of programming ads to be inserted in a programming avail;

(c) linking at least one IPG ad with at least one programming ad to form at least one IPG-programming ad combination;

(d) displaying one or more IPG ads from the at least one IPG-programming ad combination in the IPG when the IPG is invoked immediately prior to or immediately subsequent to the display of a programming ad in the programming avail, wherein the IPG ads are displayed in accordance with the IPG ad queue; and

(e) reordering the IPG ad queue in accordance with the displayed programming ad.

29. The method of claim 28 further comprising:

(f) reordering the programming ad queue according to the displayed programming ad.

30. The method of claim 28 wherein at least one of the IPG ad queue and the programming ad queue includes unscheduled ads.

31. A method of enhancing the effectiveness of IPG ads and programming ads in a television network environment, the method comprising:

(a) storing an IPG ad queue, the IPG ad queue containing an ordered list of IPG ads;

(b) storing a programming ad queue, the programming ad queue containing an ordered list of programming ads to be inserted in a programming avail;

(c) linking at least one IPG ad with at least one programming ad to form at least one IPG-programming ad combination;

(d) displaying one or more IPG ads from the at least one IPG-programming ad combination in the IPG when the IPG is invoked immediately prior to or immediately subsequent to the display of a programming ad in the programming avail, wherein the IPG ads are displayed in accordance with the IPG ad queue; and

(e) reordering the IPG ad queue in accordance with a reordering of the programming ad queue.

32. The method of claim 31 further comprising:

(f) reordering the programming ad queue according to the displayed programming ad.

33. The method of claim 31 wherein at least one of the IPG ad queue and the programming ad queue includes unscheduled ads.

34. The method of claim 31, wherein at least one of the IPG ads or at least one of the programming ads is a targeted ad, thus forming a targeted IPG-programming ad combination.

35. The method of claim 34, wherein the targeted IPG-programming ad combination is assigned to at least one subscriber group, the at least one subscriber group comprising at least one subscriber.

36. The method of claim 35, wherein the targeted IPG-programming ad combination is formed prior to the assignment of the combination to the at least one subscriber group.

37. The method of claim 35, wherein the targeted IPG-programming ad combination is formed subsequent to the assignment of at least one IPG ad or at least one programming ad to the at least one subscriber group.

38. The method of claim 31, wherein viewer interaction with an IPG ad allows a viewer to request additional information regarding a particular linked programming ad.

39. The method of claim 31, wherein viewer interaction with an IPG ad causes a related linked programming ad to be subsequently displayed.

40. The method of claim 31, wherein at least one IPG ad is displayed in the IPG when the IPG is invoked during the presentation of one of the programming ads.

41. The method of claim 28 wherein the reordering of step (e) includes changing the order of the IPG ads within the IPG ad queue.

42. The method of claim 31 wherein the reordering of step (e) includes changing the order of the IPG ads within the IPG ad queue.

(I) EVIDENCE APPENDIX

None.

(J) RELATED PROCEEDINGS APPENDIX

None.

REMARKS

This paper is being filed in response to the Notice of Non-Compliant Appeal Brief ("Notice"). The Notice contends that Applicants' Appeal Brief, filed on June 18, 2007, does not fully comply with the requirements for the contents of an Appeal Brief set forth in 37 C.F.R. § 41.37(c)(1)(v). In particular, the Notice points out that the Appeal Brief does not properly state the grounds of rejection to be reviewed on appeal.

Applicants have submitted herewith an Amended Appeal Brief, in accordance with MPEP § 1205.03. Section (F) has been amended to include the grounds of rejection to be reviewed upon appeal in accordance with the Examiner's comments. Section (G) has been amended to include headings corresponding to the grounds of rejection in amended Section (F). Applicants believe that the Amended Appeal Brief addresses all of the concerns raised in the Notice, including properly stating the grounds of rejection to be reviewed on appeal. All other sections of the Appeal Brief, including the substance of the arguments presented in Section (G) remain unchanged with respect to the Appeal Brief as initially filed. Accordingly, Applicants respectfully request entry of the Amended Appeal Brief.

In view of the foregoing, Applicants respectfully submit that the alleged deficiencies identified in the Notice have been corrected and that Appeal Brief as amended herein is in compliance with the requirements set forth in 37 C.F.R. §41.37(c). Applicant respectfully requests that the Appeal Brief be passed to the Board for reversal of the Examiner's rejections and remand of this application for issue.

Respectfully submitted,

Date: 10/23/07

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